

Application No. 10/607,916

Reply to Office Action

REMARKS/ARGUMENTS

RECEIVED
CENTRAL FAX CENTER
AUG 01 2006

Restriction Requirement

The Office Action sets forth a restriction requirement between the following groups of claims:

- (I) claims 1-14 (drawn to a magnetic carrier comprising iron oxide coated silica);
- (II) claims 15-18 (drawn to a method of isolating a substance using the magnetic carrier of claim 1); and
- (III) claims 19-24 (drawn to a method of preparing the magnetic carrier of claim 1).

Applicants' Election

Applicants elect, with traverse, the claims of Group I (i.e., claims 1-14).
Reconsideration of the requirement for restriction is respectfully requested.

Discussion of the Restriction Requirement

Groups I, II, and III allegedly are unrelated because the claims are drawn to a product, process of use, and process of preparing. According to the Office, distinctiveness can be shown for claims with these types of relationships if the processes can be practiced with a materially different product or the product can be used in materially different processes. Applicants respectfully submit that the restriction requirement is improper for the reasons set forth herein and, therefore, request withdrawal of the restriction requirement.

The Manual of Patent Examining Procedure (M.P.E.P.) recites the requirements for a proper restriction requirement. In particular, the M.P.E.P. states:

There are two criteria for a proper requirement for restriction between patentably distinct inventions:

- (A) The inventions must be independent (see MPEP Section 802.01, Section 806.04, Section 808.01) or distinct as claimed (see MPEP Section 806.05 - Section 806.05(i)); and

Application No. 10/607,916

Reply to Office Action

(B) There must be a serious burden on the examiner if restriction is required (see MPEP Section 803.02, Section 806.04(a) - Section 806.04(i), Section 808.01(a), and Section 808.02).

(M.P.E.P. § 803 (emphasis added)). These are two separate criteria that must be satisfied to support a proper restriction requirement. The fact that *both* criteria must be satisfied is made all the more clear by the following statement in the M.P.E.P.:

If the search and examination of an entire application can be made without serious burden, the examiner *must* examine it on the merits, even though it includes claims to independent or distinct inventions.

(M.P.E.P. § 803 (emphasis added)). Thus, if the subject matter of the pending claims is such that there would be no serious burden on the Examiner to search and examine all of the pending claims at the same time, the Examiner is to do so, *even if* the pending claims are drawn to independent or distinct inventions.

Applicants respectfully submit that the restriction requirement as between the claims of Groups I, II, and III is improper because the nature of the claims is such that any burden encountered in searching the groups together would, at most, be slight (and certainly not "serious"). In this respect, the claims of Group I (claims 1-14) are directed to a magnetic carrier. The claims of Group II (claims 15-18) are directed to a method of using the magnetic carrier of claim 1 (i.e., Group I). Similarly, the claims of Group III (claims 19-24) are directed to a method of preparing the magnetic carrier of claim 1 (i.e., Group I). As such, any search and consideration of the claimed subject matter of Group I will necessarily overlap the search and consideration of the claimed subject matter of Groups II and III.

Accordingly, there would appear to be sufficient similarity between the claims of Groups I, II, and III to allow for the search and examination of the subject matter of claims 1-24 at the same time without a "serious burden" being placed on the Examiner. Applicants, therefore, respectfully request withdrawal of the restriction requirement, and respectfully submit that the claims of Groups I, II, and III should be examined together. If, however, the restriction requirement is not withdrawn, Applicants request that the claims of Group II (i.e., claims 15-18) and Group III (i.e., claims 19-24) be rejoined for examination upon an indication of allowable subject matter and to the extent the claims of Groups II and III are


Application No. 10/607,916

Reply to Office Action

drawn to a method of using or producing a magnetic carrier as recited in an allowed claim of elected Group I.

For the foregoing reasons, Applicants respectfully request the withdrawal of the restriction requirement and examination of all the pending claims at this time. If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned attorney.

Respectfully submitted,


John Kilyk, Jr., Reg. No. 20,763
LEYDIG, VOIT & MAYER, LTD.
Two Prudential Plaza, Suite 4900
180 North Stetson Avenue
Chicago, Illinois 60601-6780
(312) 616-5600 (telephone)
(312) 616-5700 (facsimile)

Date: August 1, 2006